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OFFICE OF PETITIONS

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901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

In re Patent No. 7,756,814	:	
Fischer, et al.	:	DECISION ON APPLICATION
Issued: July 13, 2010	:	FOR PATENT TERM
Application No. 10/656,208	:	ADJUSTMENT AND NOTICE OF
Filed: September 8, 2003	:	INTENT TO ISSUE CERTIFICATE
Attorney Docket No. 07781.0086-00	:	OF CORRECTION

This is in response to the "Notice of Possible PTO Error in the Determination of Patent Term Adjustment and Request for Review of Calculation" filed December 8, 2009, which will be treated as a petition under 37 CFR 1.705(b)¹. Applicants requests that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be reflected as 195 days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is **four hundred and eleven (411) days is GRANTED TO THE EXTENT INDICATED HEREIN.**

On November 24, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment was 276 days. On December 8, 2009, patentees submitted the instant petition. Patentees maintain that the patent term adjustment indicated on the Determination of Patent Term Adjustment is incorrect and state specifically:

Applicants believe that there should have been a 49

¹ It is noted that the instant petition was filed on December 18, 2009, prior to the payment of the issue fee. It is further noted that the application has since matured into U.S. Patent No. 7,752,628 and that additional adjustment to the patent term is warranted. This decision is being treated under 37 CFR 1.705(b), notwithstanding. If patentees determine that a petition under 37 CFR 1.705(d) is appropriate, patentees must filed said petition with two months of the date of issuance patent and the petition should be accompanied by the appropriate fee under 37 CFR 1.18(e).

day reduction of the patent term adjustment for the Request for Continued Examination filed on May 17, 2007, and a 33 day deduction from the date the Applicant filed the Request for Continued Examination on May 17, 2007 to the date that a further Information Disclosure Statement was filed on June 19, 2007. Further, Applicants believe that the 58 day deduction of patent term adjustment from the October 28, 2008 filing date of a Response to the December 24, 2008 filing date of an Information Disclosure Statement should be a 57 day deduction. Although the Transaction History on PAIR indicates that the Response was filed on October 27, 2008, the Response was filed on October 28, 2008...

Excerpt taken from "Notice of Possible PTO Error in the Determination of Patent Term Adjustment and Request for Review of Calculation" filed March 24, 2010, p. 2.

Applicants' arguments have been considered and are well taken, in most respects.

Relative to the proposed 49 day reduction to the patent term adjustment for the filing of the Request for Continued Examination on May 17, 2007, the record reflects that a final Office Action was mailed August 22, 2006, and the response tolling the period under 37 CFR 1.704(b) was filed on January 29, 2007, in the form of a Notice of Appeal. The filing of the Notice of Appeal on January 29, 2007, began the period of appeal and the filing of the Request for Continued Examination on May 17, 2007, ended that period. There is no indication that entry of a period of reduction to the patent term was warranted in this instance.

Relative to the proposed 33 day reduction to the patent term adjustment for the filing the Information Disclosure Statement on June 19, 2007, the record reflects that on June 19, 2007, patentees submitted a supplemental reply or paper in the form of an Information Disclosure Statement (IDS) after filing a reply in the form of a Request for Continued Examination on May 17, 2007. The record does not support a conclusion that the examiner expressly requested the filing of the IDS. Further, a review of the IDS, filed June 19, 2007, reveals that applicant did not include a statement under 37 CFR 1.704(d).² Thus,

² Pursuant to 37 CFR § 1.704(d):

applicant failed to engage in reasonable efforts to conclude prosecution of the application. Accordingly, the period of adjustment should have been reduced by 33 days pursuant to 37 CFR 1.704(c)(8), counting the number of days beginning on the day after the date the initial reply was filed, May 18, 2007, and ending on the date that the IDS was filed, June 19, 2007. **A period of reduction of 33 days will be entered accordingly.**

Patentees further note that the period of reduction of 58 days to the patent term under 37 CFR 1.704(c)(8) for the filing of a IDS on December 24, 2008, is incorrect in that said period should be 57 days. Patentees argument is well taken as a review of the file history reveals that the response under 37 CFR 1.704(b), to which the IDS filed December 24, 2008, was a supplemental paper, was filed October 28, 2008, not October 27, 2008, as PALM records indicate. Accordingly, the period of reduction under 37 CFR 1.704(c)(8) is 57 days, with said period beginning October 29, 2008, and ending December 24, 2008. **The period of 58 days is being removed and a period of 57 will be entered.**

It is noted that a reduction to the patent term of 120 days was entered for the filing of the instant petition. Pursuant to 37 CFR 1.704(e), the filing of the petition under 37 CFR 1.705(b) will not be considered a failure to engage in reasonable prosecution of the application under 37 CFR 1.704(c)(10). **Accordingly, the period of reduction of 120 days is being removed.**

In view thereof, the revised determination of the patent term adjustment is **411 days** (681 days of Office delay³ - 0 days of overlap - 270 days of applicant delay).

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

³ This period of "Office delay" includes 539 days of "A" examination delay" and 142 days of "B" over three year delay. The "B" period was reduced by 108

Deposit account 06-0916 will be charged \$200.00 for the fee set forth under 37 CFR 1.18(e).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred and eleven (411) days**.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

days for the appeal period which began with the filing of the notice of appeal on January 29, 2007. The Office reminds patentees that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). In this instance, the period consumed by appellate review is 250 days, beginning on the date on which the notice of appeal to the Board of Patent Appeals and Interferences was filed, January 29, 2007, and ending on the day before the Request for Continued Examination was filed, May 16, 2007. Thus, the B delay is 142 days (250 - 108).

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UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,756,814 B2

DATED : Jul. 13, 2010

INVENTOR(S) : Fischer et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (323) days

Delete the phrase "by 323 days" and insert -- by 411 days--